IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Bruce L. Davis
Application No.: 10/086,180
Filed: February 25, 2002
For: DISTRIBUTION AND USE OF TRUSTED PHOTOS
Examiner: D Lazaro
Date: August 7, 2008

Art Unit 2155
Confirmation No. 1232

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REPLY BRIEF

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Sir:

This brief is responsive to the Examiner's Answer mailed June 11, 2008.

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I. GOVERNMENT ARCHIVE

On pages 5 and 12, the *Examiner's Answer* tries to turn Applicant's remarks concerning enablement, into admissions relating to obviousness.

In January, 2006, the Office issued an Action rejecting claims on enablement grounds. The Examiner contended, e.g., "*There is no information describing how a government agency's image archive could be incorporated into a system such that an individual user's image could be solicited and accessed from the web site.*"

In response, Applicant noted that – as a matter of "*technical enablement*" – implementation is straightforward (May 2006 Amendment, page 7). Applicant explained that an image archive (database) does not technically differ because it is a government archive. Conventional database techniques known from other image archives could be used to perform the claimed soliciting/accessing features of the method – techniques that were well within the technical capabilities of the artisan.

Since the remarks concerned enablement, they presumed the artisan was working from Applicant's specification. The *Answer* unfairly seeks to construe these remarks to suggest that an artisan – without knowledge of Applicant's specification – would have found the claimed use of a government archive to have been obvious.

Such argument does not aid the rejection, but rather highlights its deficiency.[1]

[1] The Office's assertion that the "government" limitations in the claims should be given no patentable weight, because they are "descriptive," has the same effect. *C.f.*, Final Rejection, pages 3 and 4.

II. NEW GROUNDS OF REJECTION

The *Examiner's Answer* contains new grounds of rejection, while denying same.

Under the heading *Grounds of Rejection*, the *Answer* asserts:

> The rejections have been clarified in relation to the reasoning for obviousness in order to simplify the examination of the issues on Appeal. However, the grounds of rejection have not changed...[2]

Unlike a § 102 rejection, a § 103 rejection requires more than simply citing appropriate prior art. To be sustained, the Office must also present a rationale that satisfactorily explains why the cited art would have been obviously combinable to yield the claimed invention.

In the *Examiner's Answer*, the Office has changed the presented rationales, *e.g.*, for independent claims 1,[3] 5[4] and 11[5] (and thus, similarly, for claims dependent thereon). This changes the substance of the rejections – nothwithstanding that the cited art is unchanged.

If the changes to the rationales are believed necessary to the rejections, the Office should expressly declare them to be new grounds of rejection (per MPEP § 1207.03) and permit Appellant a fair opportunity to react to same (e.g., by submitting evidence of secondary considerations, etc.).

Otherwise, the Board's review should be limited to the rejections that were made when prosecution was open, and from which Appellant appealed, *i.e.* the March 30, 2007, statements of rejection.

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2 *Examiner's Answer*, top of page 4.

3 *Examiner's Answer*, pages 5 and 13.

4 *Examiner's Answer*, pages 6 and 15.

5 *Examiner's Answer*, page 7.

III. CONCLUSION

The Board is requested to reverse the Examiner and remand for issuance of a Notice of Allowance.

Respectfully submitted,

Date: August 7, 2008

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